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PRECEDENT OF THE TTAB

Hearing:
10 November 2004

Mailed:
February 17, 2005
AD

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Gibson Guitar Corp.
v.
J. D'Addario & Co., Inc.

Cancellation Nos. 92041175 and 92041688

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Gibson Guitar Corp.

Gerald T. Bodner of Bodner & O'Rourke, LLP for J. D'Addario
& Co., Inc.

Before Quinn, Chapman, and Drost, Administrative Trademark
Judges.

Opinion by Drost, Administrative Trademark Judge:

On March 26, 2002, the U.S. Patent and Trademark Office
issued two registrations to J. D'Addario & Co., Inc.
(respondent) for the marks EXP (No. 2,554,110) and EXP
COATED (No. 2,554,111),¹ both in typed form for goods
identified as "strings for musical instruments" in Class 15.

¹ Both registrations were based on applications filed December 8,
2000, and both allege a date of first use anywhere and in
commerce of January 22, 2001.

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On October 16, 2002, Gibson Guitar Corp. (petitioner) filed petitions to cancel respondent's registrations on the ground that:

Gibson owns the trademark EXPLORER in connection with stringed musical instruments. Gibson has used the EXPLORER mark since at least as early as December 31, 1958. Gibson and the consuming public know the EXPLORER guitar as EXP and EX. Consumers use EXP or EX as a short form designation for the EXPLORER guitar. On price sheets and order forms, GIBSON uses EXP or EX as a designation for the EXPLORER. Therefore, Gibson owns the rights to the EXP trademark and the EX trademark in connection with stringed instruments.

92041175 Petition to Cancel (the '175 petition), § 1. See also 92041688 Petition to Cancel (the '688 petition). Respondent denied the salient allegations of the petitions to cancel. On May 17, 2003, the board granted petitioner's motion to consolidate these two cancellation proceedings.²

The Record

The record consists of the following items: the files of the involved registrations; the trial testimony deposition and rebuttal deposition of petitioner's president, Davis S. Berryman, with accompanying exhibits and the trial testimony deposition of respondent's president and chief executive officer, James D'Addario, with accompanying exhibits.³

² An oral hearing was held on November 10, 2004.

³ Petitioner's Brief (pp. 8-9) identifies these depositions as part of the record and then indicates that "when trial testimony is filed with the Board, it automatically constitutes part of the evidentiary record." Petitioner then indicates that some of the Berryman exhibits were filed and certain pages and exhibits of

Discussion

In this consolidated proceeding, petitioner, who produces guitars and other musical instruments, is attempting to cancel the registrations of respondent, who produces strings for musical instruments. The initial questions that we address are whether petitioner has standing and whether it has shown a valid ground for cancellation. Young v. AGB Corp., 152 F.3d 1377, 47 USPQ2d 1752, 1754 (Fed. Cir. 1998) ("Section 14 has been interpreted as requiring a cancellation petitioner to show (1) that it possesses standing to challenge the continued presence on the register of the subject registration and (2) that there is a valid ground why the registrant is not entitled under law to maintain the registration") (internal quotation marks omitted).

For standing, petitioner asserts its use of the unregistered term EXP⁴ as a "short hand designation" for its EXPLORER guitars. Petitioner asserts that it "owns the rights to the EXP trademark and the EX trademark in

the D'Addario deposition were also filed. Respondent's brief does not summarize the record. There are complete copies of all the depositions with exhibits in the file and since both parties refer to pages and exhibits in addition to the specific ones set out in petitioner's "Description of Relevant Portion of the Record," we consider the entire depositions with exhibits to be of record.

⁴ While petitioner referred to the term EX also, the case appears to have been tried on the issue of petitioner's rights in EXP. To the extent that the term EX is an issue, it is subsumed in our discussion of EXP.

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connection with stringed instruments." '175 Petition to Cancel at 2. Petitioner further maintains that it will be harmed by the registrations sought to be cancelled.

Under the rule of Otto Roth, a party opposing registration of a trademark due to a likelihood of confusion with his own unregistered term cannot prevail unless he shows that his term is distinctive of his goods, whether inherently or through the acquisition of secondary meaning or through "whatever other type of use may have developed a trade identity." Otto Roth & Co. v. Universal Foods Corp., 640 F.2d 1317, 209 USPQ 40, 43 (CCPA 1981). The Otto Roth rule is applicable to trademark registration cancellation proceedings as well.

Towers v. Advent Software Inc., 913 F.2d 942, 16 USPQ2d 1039, 1041 (Fed. Cir. 1990) (full citation added).

Inasmuch as there is no indication that the term EXP is descriptive for guitars, petitioner has shown that it has standing and it has set out a valid ground for cancellation, i.e., likelihood of confusion. Therefore, we proceed to the discussion of priority.

Petitioner does not assert ownership of a federal registration so it is relying on its common law rights in the use of the term EXP.⁵ The question then becomes whether petitioner or respondent has priority of use. Inasmuch as

⁵ Petitioner has not introduced a status and title copy of its registration for the mark EXPLORER and the issue of whether EXP and EXPLORER are confusingly similar was not tried. See, e.g. Petitioner's Brief, Statement of the Issue (p. 6) (Whether "Registration No. 2,554,110 for the mark EXP should be cancelled because (1) Petitioner Gibson Guitar Corp. ('Gibson') owns the trademark EXP in connection with guitars, (2) Registrant's mark

respondent's registrations are based on applications filed on December 8, 2000, and that respondent does not assert a date of first use prior to the filing date of the applications, in order to establish priority, petitioner must establish a date of first use prior to December 8, 2000.⁶ 15 U.S.C. § 1057(c). See also Zirco Corp. v. American Telephone and Telegraph Co., 21 USPQ2d 1542, 1544 (TTAB 1991).

Petitioner argues (Brief at 13) that since "at least September 15, 1993, Gibson has been using the mark EXP to designate its EXPLORER guitars." If petitioner can establish this date, it would clearly be well prior to respondent's constructive use date of December 8, 2000. Before we begin a discussion of petitioner's evidence for its priority date, we note two features of this evidence. First, all of the uses by petitioner involve petitioner's use of the term EXP with other letters and/or numbers.⁷ Second, petitioner's evidence of use consists primarily of use of the term EXP as part of a model abbreviation. See '175 Petition to Cancel at 1 (On price sheets and order forms, GIBSON uses EXP..."). Petitioner has sold a guitar

is likely to create confusion with Gibson's mark, and (3) Gibson is the senior user in the United States").

⁶ Petitioner admits that "Registrant's intent to use applications were filed December 8, 2000, giving Registrant a priority date of December 8, 2000." Reply Brief at 6.

under the name "Explorer" since 1958. Berryman dep. at 8. According to petitioner's witness, "it's commonly referred to as EXP." Id. Petitioner submitted the following evidence to support its claim that EXP is an abbreviation for its EXPLORER mark.

Petitioner's first piece of evidence (Berryman Ex. 1) is a document entitled "Epiphone®"⁸ - "U.S.A. Suggested Retail Price List effective September 15, 1993." The document consists of two pages with a series of columns of information. Under the column identified as "Family Code," numerous codes are listed including: EA20, EA3T, EE35, EP5, EFD1, EFB2EGT1, ETS2, EBAC, EIZE, and ENS1. On page 2, the following examples appear among thirteen entries in a section entitled "Solid Body Electric Collection."

<u>Family Code</u>	<u>Model/Case</u>	<u>Finish</u>	<u>H/W</u>	<u>Inst.</u>	<u>Case</u>
EGM2	EM-2/EPIGIG	BM,BU,PW,RM	GF	\$- ⁹	\$-
EXP1	Explorer/EEXP	AW,EB,RE	CH	\$-	\$-
EES1	Stiletto/ENLCPS	AW,EB,FB,RM,SM	CH	\$-	\$-

According to the legend, AW stands for alpine white, BM is black metallic, EB is ebony, etc. The abbreviation CH stands for chrome hardware.

⁷ Berryman Ex. 14 shows use of the term EXP on a warranty card but it was not used until April 2001, which is after respondent's December 8, 2000, priority date. See Berryman dep. at 30.

⁸ "Epiphone is another brand that is owned by Gibson Guitar." Berryman dep. at 7.

⁹ Inasmuch as the document has been marked confidential, prices have not been included even though these documents were apparently shown to potential customers (Berryman dep. at 14),

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Berryman Exhibits 2, 3, 4, and 5¹⁰ are similar price lists for 1994, 1995, 1996, and 1997 consisting of two or three pages with more than one hundred entries. They too contain an entry that reads "Explorer" with "EXP1" under Model Code with a listing of colors and various prices. Exhibit 7 contains entries for "'1958' Explorer" and "'1958' Korina"¹¹ Explorer" followed by the entry "EXP2" in the column titled "Instr. Code."¹²

Petitioner also introduced a number of invoices that contained, *inter alia*, the following entries in the category "Product No.": EXP2EBGH1 (See GIB 00010, 00011) and EXP2KOGH1 (See GIB 00018). These invoices list the model descriptions as "'1958' Explorer Ebony GLD HDWE" and "'1958' Korina Explorer GLD HDW."¹³

Reviewing the evidence of record, we would be hard pressed to find evidence of technical trademark usage. There is no evidence that petitioner has used the term EXP by itself in any context prior to respondent's priority date. There is significant evidence that petitioner's

because the prices are not relevant to any issue under consideration in these proceedings.

¹⁰ Exhibits 4 and 5 are marked "For DSM [District Sales Managers'] Use Only." See Berryman dep. at 124. Exhibits 2 and 3 appear to be confidential dealer price lists that would not be sent to the consuming public. Berryman dep. at 123 ("[U]nlike the other price lists, these price lists contain the pricing after the dealers' discount, which obviously we would never send these to the consumer").

¹¹ Korina is a type of wood. Berryman dep. at 193.

¹² Mr. Berryman indicated (p. 199) that EXP1 and EXP2 referred to "Explorer single pickup, double pickup."

guitars are identified as EXPLORER guitars. However, petitioner is not arguing that there is any confusion between that mark and respondent's EXP or EXP COATED marks. Rather petitioner argues that it has rights in EXP and that there is a likelihood of confusion between that mark and respondent's marks.

A key question, therefore, is whether petitioner has demonstrated that its use of EXP is use analogous to trademark use or that others use the term EXP to refer to petitioner's guitars. See National Cable Television Association Inc. v. American Cinema Editors Inc., 937 F.2d 1572, 19 USPQ2d 1424, 1428 (Fed. Cir. 1991) ("The evidence is profuse that Editors has publicly been known as ACE since prior to 1979, as attested to by members of Editors, as well as shown by newspaper articles and third party correspondence where the name American Cinema Editors has routinely been shortened to ACE"). Furthermore, we can consider that "abbreviations and nicknames of trademarks or names used *only* by the public [can] give rise to protectable rights in the owners of the trade name or mark which the public modified." Id. (emphasis in original).

Before a prior use becomes an analogous use sufficient to create proprietary rights, the petitioner must show prior use sufficient to create an association in the minds of the purchasing public between the mark and the petitioner's goods. A showing of analogous use does not require direct proof of an association in the

¹³ Most of these invoices are dated between 1997 and 1999.

public mind. Nevertheless, the activities claimed to create such an association must reasonably be expected to have a substantial impact on the purchasing public before a later user acquires proprietary rights in a mark.

Herbko International Inc. v. Kappa Books Inc., 308 F.3d 1156, 64 USPQ2d 1375, 1378 (Fed. Cir. 2002) (citations omitted). See also American Stock Exchange, Inc. v. American Express Co., 207 USPQ 356, 363 (TTAB 1980) ("In order to rely upon a use asserted to be analogous to trademark use, such use must be an open or public use directed to the segment of industry or purchasing public for whom the party's goods or services are intended and be in a manner calculated to attract the attention of the viewer and thereby create an association of said term with such goods or services").

Inasmuch as several exhibits are specifically designated for district sales managers use only or are confidential dealers' price lists that are not shown to the ultimate customers, these documents are not a "a public use ... calculated to attract the attention of the viewer." Petitioner has not introduced any evidence that it uses the term "EXP" in its advertising nor has petitioner shown that the media refers to petitioner's guitars as EXP.

The price lists that could be shown to the public such as Exhibit 1, while not necessarily confidential, would not be calculated to reach a sizable segment of the public. The

publication is addressed "Dear Authorized Epiphone Dealer."
"An unbroken line of precedents of both this court and the Board make clear that activities claimed to constitute analogous use must have substantial impact on the purchasing public." T.A.B. Systems v. PacTel Teletrac, 77 F.3d 1372, 37 USPQ2d 1879, 1882 (Fed. Cir. 1996). Even if some customers may have been shown copies of dealers price lists and associated the term EXP with petitioner, this hardly establishes that these activities had a substantial impact on the purchasing public. Id. at 1883 ("For example, if the potential market for a given services were 10,000 persons, then advertising shown to have reached only 20 to 30 people as a matter of law could not suffice"). Furthermore, it is difficult to see how the term EXP1 would create an impression that would associate the term EXP with petitioner anymore than the terms AO20 for the PR-200/E822 or EES1 for the Stiletto/ENLCPS do. While it is possible that some customers who study the abbreviations may guess what they mean, we are concerned with the impressions of the ordinary purchasers not just with those that are clairvoyants or cryptologists.

Regarding the invoices, they all appear to be addressed to businesses and they contain entries for "Dealer Purchase Order No." and "Dealer No." See GIB 00006, 00008-00011,

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00014, 00015, 00016, 00018-00022, and 00043-00044.¹⁴ It is not clear that the consumer, as opposed to the dealer, would actually see the invoice. Also, it is not apparent that even dealers would ordinarily surgically remove the "EXP" letters from such Product No. entries as "EXP2EBGH1" and "EXP2KOGH1." This use would not lead purchasers to associate the term with petitioner as was found in the Martahus v. Video Duplication Services Inc. case. 3 F.3d 417, 27 USPQ2d 1846, 1850, 1852 (Fed. Cir. 1993) ("The TTAB's finding that VDS's use of the acronym 'VDS" at four different places in its sales invoices represented trade name use seems quite reasonable, given that such use openly identified the company by that name to its customers"). See also Sealy, Inc. v. Simmons Co., 265 F.2d 934, 121 USPQ 456, 459 (CCPA 1959) ("[T]here is no reason for this court to deny probative value to these invoices, the label on which "BABY POSTUREPEDIC" is imprinted and the testimony of both opposer's president and the licensee representative to establish trademark usage"). Indeed, some of petitioner's invoices further the confusion by following the "Product No." such as "EXP1EBCT1" with an entry in the Model Description that says "Invalid Code - Do Not Use." See GIB 0007, 00008, and 00010.

¹⁴ In GIB 00007, the entry under Dealer Purchase Order No. is "null."

Petitioner also relies on respondent's evidence that other guitar manufacturers use the term EXP. When "third parties sell these counterfeit Explorer guitars ... [t]hey usually refer to the guitar as 'EXP.'" Berryman dep. at 12. Petitioner maintains that this is a form of trademark recognition. Petitioner provided an email (Berryman Ex. 17) that one of its competitors agreed to cease use of the term EXP. Regarding another competitor, petitioner testified that he checked the party's website and it contained a statement that "due to legal problems and at Gibson's request, we have discontinued this product." Berryman Rebuttal dep. at 6. Petitioner did not introduce any printout of this website. While we have considered this evidence, we note that even petitioner's president had never heard of the identified users and, therefore, the simple fact that an alleged infringer may have used petitioner's term does not indicate that there is an association by prospective purchasers with the term and petitioner. Furthermore, even if we assume that these three competitors decided to use the term EXP because they believed that it identified petitioner's guitars, the beliefs of competitors are not conclusive to establish prospective purchasers associate the term with petitioner. We also note that the evidence that competitors of petitioner were using EXP all appear to be subsequent to applicant's priority date. See

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D'Addario Ex. C ("Peavey announces V-Type EXP Guitar" dated January 22, 2002) and Ex. D (*Guitar News Weekly*, "Legend Guitars Introduces ERA and EXP," dated February 10, 2003). Exhibit E for Ed Roman Guitars is undated except for the apparent download date "1/6/2004" and the notation that "Abstract will be able to produce close to 10 guitars a month in 2003." Evidence that petitioner's term acquired some recognition among competitors subsequent to applicant's priority date is not very persuasive evidence.

Petitioner's president also testified (dep. at 8) in response to the question: "When you say it's commonly known as the EXP, who knows it as the EXP?" as follows:

Well, of course, everybody within the company; but our dealers, retail dealers, our international distributors, and really it's held out to the general public in many respects in that regard.¹⁵

While this may be petitioner's goal, it is not clear from the record that this is in fact the case. For example, petitioner's evidence of its use of variations of the term EXP prior to respondent's filing dates consists of confidential dealers' price lists, dealers' invoices, and price lists that are available to consumers only if they request them from petitioner or if the dealer shows them to the consumer. Even if they should see the price lists, it

¹⁵ Respondent now objects to this testimony of the ground that it is hearsay. Brief at 48-49. We overrule the objection but we add that the vagueness of the statement severely limits the weight we give it.

is not clear how the code EXP1, which is preceded by dozens of similar codes, is calculated to attract the attention of the viewer. See Old Swiss House, Inc. v. Anheuser-Busch, Inc., 569 F.2d 1130, 196 USPQ 808, 810 (CCPA 1978) ("The articles mentioned above were, in effect, press releases; in all but one, the mark, THE OLD SWISS HOUSE, was buried in the body of the articles. This, in our view, is not the type of public exposure of a mark that would be expected to have any significant impact on the purchasing public").

Furthermore, in its Reply Brief (p. 8, citing to Berryman dep. at 199:19 to 200:5), petitioner argues that there "is no dispute that guitar buyers order EXPLORER guitars using the EXP mark." The entire cited testimony is set out below (emphasis added).

Q. Now when you say 'everybody knows it's Explorer,' who do you mean by 'everybody'?"

A. Well, when I say "everybody," people that deal with the product are dealers, sales people, *even some consumers*. I mean, you know, you go to a trade show, you have half dealers, half consumers. People abbreviate things all the time. And, I mean people say "Les Paul" when they write about a Les Paul, but people will say, "Well that's a nice 'LP,' you know. It's just - there's common. So "EXP" has become the term that's used. It's kind of a shorthand, in a way, for Explorer.

Petitioner's vague statement that "everybody knows," subsequently qualified to include "even some consumers," hardly amounts to an undisputed statement that "guitar buyers order EXPLORER guitars using the EXP mark." Indeed,

the cited testimony says nothing about ordering guitars unless we must finish the witness's statement for him by inserting "when ordering" after "'EXP' has become the term that's used," which, of course, we decline to do.

Furthermore, it does not address whether "everybody knew" this prior to respondent's priority date. We also find this testimony to be undercut by the record that does not show that any purchasers prior to respondent's priority date associated the term EXP with petitioner.¹⁶

Also, to the extent that the term EXP is considered a model designation, it still would not be enough to establish rights prior to respondent's priority date. Petitioner's evidence is significantly different than those cases that discussed model designations. See, e.g., General Motors Corp. v. Pacific Tire & Rubber Co., 132 USPQ 562, 564 (TTAB 1962) ("Even assuming for present purposes herein that, as applicant contends, 'BEL-AIR' has been used by opposer and serves merely as a type of model designation for opposer's 'Chevrolet' cars, it is well-established that such use of 'BEL-AIR' by opposer is sufficient to preclude registration..." Opposer's evidence included millions of dollars of sales and advertising of BEL-AIR model of

¹⁶ Respondent has objected to this testimony of petitioner's witness on several grounds. This type of testimony has been considered previously. Martahus, 27 USPQ2d at 1851-52. Again, the vagueness of the testimony affects its weight.

Chevrolet automobile); Scotto v. Mediterranean Importing Co., 162 USPQ 415, 418 (TTAB 1969) ("It is well settled ... that a party may rely on prior use of a designation, whether as a product mark or a style or type mark, in support of a cause of action in a proceeding in the Patent Office." Term appeared on labels for wine).

Finally, we not only look at the evidence individually, but we also must look at the total picture the evidence presents.

[W]hether a particular piece of evidence by itself establishes prior use is not necessarily dispositive as to whether a party has established prior use by a preponderance. Rather, one should look at the evidence as a whole, as if each piece of evidence were part of a puzzle which, when fitted together, establishes prior use.

West Florida Seafood Inc. v. Jet Restaurant Inc., 31 F.3d 1122, 31 USPQ2d 1660, 1663 (Fed. Cir. 1994).

In this case, petitioner's evidence at best demonstrates that it used the term EXP along with other letters and/or numbers on some price lists and invoices prior to respondent's priority date. Some of these documents may have been seen by prospective purchasers. Petitioner's use of the term EXP, combined with other letters and/or numbers, on confidential price lists, that may in some cases be shown to customers, and dealer invoices is simply not of the caliber of the evidence that shows that the term EXP's use was analogous to trademark use. We add

that respondent's registrations are presumed valid, and a petitioner seeking to cancel a registration must rebut this presumption by a preponderance of the evidence. Cerveceria Centroamericana S.A. v. Cerveceria India Inc., 892 F.2d 1021, 13 USPQ2d 1307, 1309 (Fed. Cir. 1989) ("[I]n a [trademark registration] cancellation for abandonment, as for any other ground, the petitioner bears the burden of proof. Moreover, the petitioner's burden is to establish the case for cancellation by a preponderance of the evidence"). See also Martahus, 27 USPQ2d at 1850. On the record in this case, petitioner has not met its burden.¹⁷

Decision: The petitions to cancel are denied.

¹⁷ In view of our disposition of the priority issue, we do not address the question of likelihood of confusion.